

The claims remaining in the application are 1, 4, 6, 7, and 9.

### REMARKS

The Applicants would like to thank the Examiner for the very quick and courteous final Office Action. The Applicants particularly appreciate the Examiner's statement that the Applicants' previous amendment distinguishes over the art of Llave.

#### Applicants' Invention

The Applicants' invention is adequately outlined in independent claim 1 as amended above.

#### Claim Objections

The Examiner objected to claims 6 and 10 under 37 CFR §1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claims or amend the claims to place the claims in proper dependent form, or rewrite the claims in independent form. Claims 6 and 10 are seen as failing to further limit the parent claims, since tallow amidopropyl amine oxide does not contain R' groups as alkyl groups, but as hydrogen. It is noted that Applicants deleted a portion of their specification to correct the implication that they did possess alkyl groups.

The Applicants appreciate the Examiner pointing out this inadvertent error, and the Examiner's attention is respectfully directed to the amendment to claim 1 herein where the words --hydrogen or-- have been inserted in the definition of R' after the phrase "R' are independently" and before the phrase "alkyl groups". This change will permit the R' groups to be hydrogen, and thus permit claim 6 to further limit the subject matter of previous claim 1 from which it depends. It is respectfully submitted that this addition does not constitute new matter because the application as filed contained recitations to tallow amidopropyl amine oxide where the R' groups in the formula (I) structure are actually hydrogen. The Examiner's attention is respectfully directed to page 4, line 4; page 6, line 8; claims 6 and 16; and elsewhere as evidence of support for this amend-

ment. This amendment has been made to claim 1 to correct an inadvertent clerical error and not for any reason related to patentability.

Because claim 10 has been canceled herein, it is respectfully submitted that the instant objection is rendered moot with respect thereto. Reconsideration is respectfully requested.

### 35 U.S.C. §102 Rejection Based on WO 99/32572

The Examiner has rejected claims 1, 4, 7, 8-10, 13, and 14 under 35 U.S.C. 102(e), as being allegedly anticipated by WO 99/32572.

The Examiner finds that WO 99/32572 teaches viscoelastic fluids which comprise a nonionic amine oxide which are used in areas such as for drilling fluids and fracturing fluids, wherein the amine oxide is the only gelling agent, referring to Example 8. Proppants and breakers may be added. The Examiner thus contends that the present invention is thus anticipated by WO 99/32572.

The Applicants must respectfully traverse.

The Examiner's attention is respectfully directed to the amendments made herein to claim 1 where the treating of the subterranean formation has been further specified as being selected from three possibilities. These three possibilities were recited in dependent claim 8 as originally filed, and thus do not constitute improper insertion of new matter. (Dependent claim 8 has been canceled as redundant.) It is noted that all of the possibilities originally recited in claim 8 have not been included in claim 1 herein.

It is respectfully submitted that a patent claim is anticipated, and therefore invalid, only when a single prior art reference discloses each and every limitation of the claim. *Glaxo Inc. v. Novopharm Ltd.*, 52 F.3d 1043, 1047, 34 U.S.P.Q.2d 1565 (Fed. Cir.), cert. denied, 116 S.Ct. 516 (1995). It is respectfully submitted that WO 99/32572 fails to do this with respect to the claims as amended. Specifically, the claims now recite that the treating of a subterranean formation as recited by claim 1 is selected from the group consisting of:

- acidizing the formation where the aqueous viscoelastic treating fluid further comprises an acid;

- stimulating the formation where the aqueous viscoelastic treating fluid further comprises a stimulating agent; and
- controlling fluid loss where the aqueous viscoelastic treating fluid further comprises a salt or solid; and mixtures thereof.

It is respectfully submitted that WO 99/32572 does not teach these limitations.

It is thus respectfully submitted that because each and every limitation of the claims has not been disclosed by the reference, the rejection must fall. That is, the amendments to the claims overcome the rejection. It is respectfully submitted that claims dependent upon claim 1 are patentable over WO 99/32572 because they also contain the distinguishing language by dependency. Because claims 10, 13-14 and 16-17 have been cancelled herein, it is respectfully submitted that this rejection is rendered moot with respect to them. Reconsideration is respectfully requested.

#### 35 U.S.C. §103 Rejection Over WO 99/32572

The Examiner has rejected claims 1, 6, 10, and 16-18 under 35 U.S.C. 103(a), as being allegedly unpatentable over WO 99/32572 for reasons of obviousness.

The Examiner finds that WO 99/32572 teaches viscoelastic fluids that comprise a nonionic amine oxide which are used in areas such as for drilling fluids and fracturing fluids, wherein the amine oxide is the only gelling agent (Example 8). The Examiner notes that proppants and breakers may be added. The Examiner admits that WO 99/32572 differs from the present invention in not specifically teaching the use of tallow amido propyl amine oxide as an amine oxide useful in the invention. However, the Examiner asserts that WO 99/32572 teaches the use of tallow amido dimethylamine oxide in the drilling and treating fluids (Example 8). As homologues and analogues with such similar structures, the Examiner alleges that they would be expected to have similar properties and utility, and further that it would be obvious to one of ordinary skill in the art to utilize various homologues and analogues of the amine oxides disclosed by WO 99/32572, including the tallow amido propyl amine oxide of the present invention, since such homologues and analogues would be expected to be useful in the viscoelastic well fluids of WO 99/32572.

The Applicants' other arguments have been considered by the Examiner but not deemed persuasive. The Applicants have argued that WO 99/32572 does not teach R' as an alkyl group averaging 1-3 carbon atoms. The Examiner asserts that this is incorrect, since the dimethyl amine of example 8 of WO 99/32572 is found by him to teach methyl groups having 1 carbon atom. Furthermore, contrary to Applicants' arguments, in addition to teaching an example using only a single amine oxide as the gelling agent, the specification at page 4, lines 17-19 clearly teach that a single gelling agent may be used. The Examiner thus contends that WO 99/32572 anticipates the present rejected claims. In addition, the Examiner states that the courts have held that homologues produced by the substitution of two methyl groups for two hydrogen atoms (each differing by  $\text{CH}_2$ ), would obviously have similar utility to one of ordinary skill in the art, absent a showing of superior and unexpected results. Thus, the Examiner alleges that the tallow amido propyl amine oxide disclosed by WO 99/32572 would render the tallow amido propyl amine oxide of the present invention for use in gelling subterranean fluids, obvious to one having ordinary skill in the art, absent a showing of superior and unexpected results.

The Applicants must respectfully traverse. It is respectfully noted that claim 1 as amended herein now recites that the treating of a subterranean formation is selected from the group consisting of:

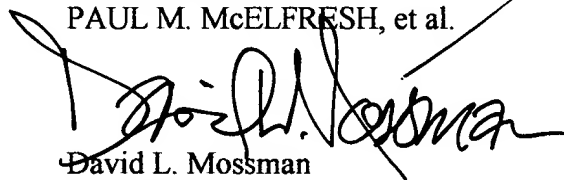
- acidizing the formation where the aqueous viscoelastic treating fluid further comprises an acid;
- stimulating the formation where the aqueous viscoelastic treating fluid further comprises a stimulating agent; and
- controlling fluid loss where the aqueous viscoelastic treating fluid further comprises a salt or solid; and mixtures thereof.

It is respectfully submitted that WO 99/32572 does not teach or suggest these treatments. WO 99/32572 only teaches that their "solution is advantageously injected into, for example, an underground system for use in drilling, hydraulic fracturing, for permeability modification of underground formations, and for uses such as gravel packing, and cementing." (Page 4, lines 14-17.) This except, nor any other portion of WO

99/32572 mentions or suggests acidizing the formation using an acid, stimulating the formation using a stimulating agent, and/or controlling fluid loss using a salt, solid or a mixture thereof. Therefore it is respectfully submitted that the Examiner has not made a *prima facie* case of obviousness of the claimed invention from WO 99/32572 under 35 U.S.C. §103. Reconsideration is respectfully requested.

It is respectfully submitted that the arguments and amendments presented above overcome the instant rejections. Reconsideration of the claims is respectfully requested. The Examiner is respectfully reminded of his duty to indicate allowable subject matter. The Examiner is invited to call the Applicants' attorney at the number below for any reason, especially any reason that may help advance the prosecution.

Respectfully submitted,  
PAUL M. McELFRESH, et al.

A handwritten signature in black ink, appearing to read "David L. Mossman", is written over the typed name and registration information.

David L. Mossman  
Registration No. 29,570  
Attorney for Applicants  
Telephone No. 915/392-8015  
Facsimile No. 915/392-8805

Madan, Mossman & Sriram, P.C.  
2603 Augusta, Suite 700  
Houston, TX 77057-5638